

Applicant: Bernard John Carroll
U.S. Serial No.: 09/701,926
Filing Date: June 1, 2001

Docket No.: 111590-120

REMARKS:

In the Communication, the Examiner indicated that the instant application contains six inventions, or groups of inventions, which are not linked so as to form a single general inventive concept under PCT Rule 13.1.

Applicant traverses the restriction requirement and requests reconsideration and withdrawal or modification of the requirement. However, in order to provide a complete response pursuant to 37 C.F.R. §1.143, applicant provisionally elects claims 1-9, 21 and 22 of Group I, drawn to an isolated phenotype modulating genetic sequence (PMGS), a method of increasing or stabilizing expression or stabilizing of a nucleotide sequence.

It is respectfully submitted that, at the least, the claims of Group I and Group II (containing claim 10 and drawn to an isolated phenotype modulating genetic sequence (PMGS), a method of inhibiting, reducing, or otherwise down regulating expression or stabilizing of a nucleotide sequence) should be examined together, as they relate to methods of affecting or modulating expression of a nucleotide sequence, which methods involve the introduction into a plant or animal, or a plant or animal cell, the nucleotide sequence flanked by, adjacent to, or otherwise proximal with a PMGS. Accordingly, the Group I and Group II claims form a general inventive concept and share a common technical feature as required under PCT Rules 13.1 and 13.2.

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It is believed that the examination of Groups I and II, which share a technical relationship involving a corresponding technical feature of modulating nucleic acid expression (PCT Rule 13.2), would not present an unreasonable task, or place an undue burden on the Examiner for searching purposes, and thus can be considered together in one application.

In addition, for Groups I-IV, the Examiner has further required restriction to one of SEQ ID NOS:1-31. It is submitted that only pending claim 20 recites nucleotide sequences (SEQ ID NOS:1-31) that comprise a PMGS. Therefore, the species election of one SEQ ID NO. should apply only to claim 20 of Group I, and not to all of the claims of Groups I-IV as stated by the Examiner.

The species election is made with traverse. The technical feature shared by the sequences recited in claim 20 is that they comprise a phenotype modulating genetic sequence (PMGS). It is believed that for the examination of the pertinent claim, it would not be an undue burden for the Examiner to search the sequences as specified in the claim.

Since only one claim in Group I recites sequences, and in view of MPEP § 803.04, it is submitted that a reasonable number of sequences for examination constitutes more than only one sequence. According to MPEP § 803.04, normally ten sequences constitute a reasonable number of sequences for examination purposes in biotechnology patent applications. It is thus requested that all of the sequences recited in

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claim 20 be examined together in this application. Should the Examiner deem that not all of the claim 20 sequences can be examined together, it is requested that at least ten of the recited PMGS nucleic acid sequences, i.e., SEQ ID NOS:1-10, be examined together without restriction in the instant application, in accordance with MPEP §803.04.

The nature of the claimed sequences is not complex (e.g., not a protein amino acid sequence reciting three dimensional folds); therefore, ten sequences is believed to be a reasonable number for examination in the instant case, without imposing an undue burden on the Examiner. However, to be fully compliant with the requirements of 37 C.F.R. §1.143, the applicant provisionally elects the nucleotide sequence of SEQ ID NO:1 herein as the species for examination.

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AUTHORIZATION:

Should any additional fees be deemed to be properly assessable in this application during its pendency, or for the timely consideration of this Response, the Commissioner is hereby authorized to charge any such additional fee(s), or to credit any overpayment, to Deposit Account No. 08-0219, Order No. 111590-120.

CONCLUSION:

In the event that the Examiner is of the opinion that further discussion is necessary, the Examiner is hereby respectfully requested to telephone the applicant's undersigned attorney at (212) 937-7258.

Respectfully submitted,

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Date: March 3, 2003

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